



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/518,327

01/21/2005

Thierry Mougin

979-102

6732

39600

7590

12/24/2009

SOFER & HAROUN LLP.

317 MADISON AVENUE, SUITE 910

NEW YORK, NY 10017

EXAMINER

COLLINS, MICHAEL

ART UNIT

PAPER NUMBER

3651

MAIL DATE

DELIVERY MODE

12/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/518,327	<b>Applicant(s)</b> MOUGIN, THIERRY	
	<b>Examiner</b> MICHAEL K. COLLINS	<b>Art Unit</b> 3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,5-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 9/03/2009 with respect to claims 11-13 have been fully considered but they are not persuasive. The Applicant argues, "Claim 11 is primarily an apparatus claim, which is dependent to method claim 1." It is precisely for this reason that claims 11-13 stand rejected because a dependent apparatus claim cannot depend from an independent method claim without be ambiguous. Therefore, this argument is not convincing.
2. Applicant's arguments with respect to claims 1, 5-8, 10, and 14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - Regarding claim 11 the Applicant discloses "An apparatus for delivering goods or services against payment of the automatic type, employing the method for diagnosing malfunctions as set forth in claim 1." The Applicant amended independent claim 1 but in so doing has made unclear whether all of the

limitations of claim 1 are in the dependent claim 11 (see MPEP 608.01(n)). More specifically, MPEP, section 2173.05(p) states, "A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph." Id. Claim 11 and its dependent claims 12-13 recite the **machine** including an apparatus for delivering goods or services and the **method** comprising the method for diagnosing malfunctions. Since claim 11 and its dependent claims 12-13 claim both an apparatus and the method steps of using the apparatus, these claims are indefinite.

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 11-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, claim 11 is directed to neither a "process" nor a "machine", but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. See, MPEP, section 2173.05(p). In particular, claims 11-13 recite both a process and a machine.

#### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3651

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 5-8, 10 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by

or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hiltz et al. (USP

6,111,522).

Regarding claim 1, Hiltz et al. disclose a method for diagnosing malfunctions occurring on an automatic terminal type apparatus (10) for delivering goods or services against payment, received at one of at least two different means of payment (18,40), said method for diagnosing malfunctions comprising the steps of:

- for each means of payment, calculating the value of at least one respective data item representative of an operation of said apparatus (see column 9 lines 45-58), wherein said at least one data item representative of the operation of said apparatus is an amount of time that has elapsed since a latest payment made with the means of payment and the time that is intended to elapse as long as no other payment is made with the means of payment (see column 9 lines 45-58);

Art Unit: 3651

- comparing each calculated value to a respective predetermined reference value (see column 9 lines 45-58); and
- deducing the occurrence of a malfunction in the event one of the calculated values is superior to its predetermined reference value (see column 9 lines 45-58).

Regarding claim 5, Hiltz et al. disclose a method according to claim 1, wherein said reference value is representative of the average of values taken by said data item representative of the operation of the apparatus.

Regarding claim 6, Hiltz et al. disclose a method according to claim 1, wherein said reference value depends at least on a parameter such as the time of day or the apparatus concerned (see column 9 lines 41-44).

Regarding claim 7, Hiltz et al. disclose a method according to claim 1, wherein predetermined difference depends at least on a parameter such as the time of day or the apparatus concerned (see column 9 lines 41-58).

Regarding claim 8, Hiltz et al. disclose a method according to claim 1, wherein the operations of calculating a data item representative of the operation of said apparatus and comparing the calculated value and a predetermined reference value are affected directly by said apparatus (see column 9 lines 45-58).

Regarding claim 10, Hiltz et al. disclose a method according to claim 1, wherein said apparatus is a terminal for paying for parking spaces, such as a parking voucher dispenser or a parking meter (10).

Regarding claim 14, Hiltz et al. disclose the method according to claim 1, wherein each reference value is obtained by direct statistical analysis of observed raw data of several automatic terminal type apparatuses including said terminal type apparatus.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL K. COLLINS whose telephone number is (571)272-8970. The examiner can normally be reached on 8:30 am - 5:00 pm M-F.

Art Unit: 3651

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene O. Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.K.C.  
12/18/2009

/Gene Crawford/  
Supervisory Patent Examiner, Art  
Unit 3651